

REMARKS

Requirement For Restriction

The provisional election of group I, claims drawn to the pigment and pigment-containing product, is hereby affirmed. The election is made with traverse.

The traversal of the restriction requirement is based upon the fact that the claims to the method of making the pigment, classified in group II, are related to the claims of group I as combination to subcombination. Specifically, the method claims are combination claims, inasmuch as they require all the elements of the product claims i.e., they require production of a product of claims of group I. In such situation, 2-way distinctness must be shown, specifically, that the method can be used to produce a different product. Such has not been found. Moreover, it is submitted that claims to the method of making the pigments will be *per se* allowable once the pigment and product claims are allowed. Thus, rejoinder will proper under MPEP § 821.04. In such a situation, where there is little, if any, additional effort in order to search the method claims, MPEP § 803 mandates that the claims be maintained together in the same application. Accordingly, withdrawal of the restriction requirement is respectfully requested.

Rejections Under 35 U.S.C. 112

Claim 14 has been rejected as depending upon withdrawing claim 10. Indeed, claim 14 is a product by process claim, depending upon a withdrawn process claim. Applicant is not aware of any prohibition against a claim depending upon a withdrawn claim. The withdrawal of the rejection is therefore respectfully requested.

The amendment of claim 19 obviates the remainder of the rejection, withdrawal of the same is respectfully requested.

Rejections Under 35 U.S.C. 102

Claims 1-4, 6-9, 14-18, 21, 22, 24 and 25 have been rejected under 35 U.S.C. 102(b) over Schmidt '070. Reconsideration of this rejection is respectfully requested.

To constitute anticipation, all material elements of the claim must be found in one prior

art reference. See, for example, *In re Marshall*, 577 F.2d 301, 198 USPQ 344 (CCPA 1978). However, a reference which does not at least render a composition and that are obvious cannot "describe" the composition as the term is used in 35 U.S.C. 102, see *In re Kalm*, 378 F.2d 959, 154 USPQ 10 (CCPA 1967). In particular, this reference is not anticipatory where one of ordinary skill in the art would have to choose judiciously from a genus of possible combinations, *In re Sivaramakrishnan*, 673 F.2d 1382, 213 USPQ 441 (CCPA 1982). At columns 3 and 4 of the '070 patent, various metals are listed from which one of ordinary skill in the art can select a layer A, a layer B, and a layer C. Patentees teach that these layers can be put together as A, B, C or in a variety of other orientations. See the top of column 4. As a result, it is not seen of one of ordinary skill in the art is given sufficient direction so as to be taught the particular composition of layers claimed in, for example, independent claim 1. It is thus respectfully submitted that the patent does not anticipate the present claims. Inasmuch as the patent does not anticipate independent claim 1, it cannot anticipate the other claims above named, which are dependent thereon. With respect to claim 14, dependent upon process claim 10, it is not seen the patentees teach a product produced by the process recited in claim 10. Accordingly, withdrawal of this portion of the rejection is also respectfully requested.

Claims 1-3, 6-9, 14-18, 21 and 22 have also been rejected under 35 U.S.C. 102(e) over Bauer '018. In this reference, as in the above discussed rejection, one of ordinary skill in the art must select various metals from among a generic disclosure, and must also find the teaching to provide at least two layers of such oxides. Again, one of ordinary skill in the art is faced with discerning the invention from a generic disclosure and, as a result, it is submitted that the patent does not anticipate the present claims. Withdrawal of this rejection is also again respectfully requested.

Claims 1, 6-9 and 14-18 have been rejected under 35 U.S.C. 102(b) over two commercial pigments: *Cloisonne Regal Gold* and *Flamingo Twilight Gold*. Reconsideration of this rejection is also respectfully requested.

Although the disclosures indicate that various oxides used therein, the disclosure does *not* indicate whether the oxides are applied as separate layers, or as a mixture. Moreover, disclosures do not teach that at least two layers of metal oxides in accordance with the invention are applied.

Accordingly, these references fall far short of anticipating the present claims, and withdrawal of this rejection is also respectfully requested.

Claims 1, 6-9 and 14-18 have also been rejected under 35 U.S.C. 102(b) over Linton '828 and Nitta '034. Reconsideration of this rejection is also respectfully requested. Linton is predominantly directed to incorporation of additional metals *within* a titanium dioxide layer. See, for example, lines 65-70 of column 5. To the extent that a second layer of metal oxide is disclosed, for example at column 6, lines 49+, a long list of possible metal oxides is given. Thus, again, one of ordinary skill in the art has to make a judicious selection in order to arrive at a composition within the scope of the present claims, and this reference also falls far short of an anticipation. With respect to Nitta, as with the aforesaid references, the generic disclosure (for example, at column 3, lines 22-30) requires judicious selection by one of ordinary skill in the art. Accordingly, this reference also does not anticipate the present claims, and withdrawal of this rejection is also respectfully requested.

Rejections Under 35 U.S.C. 103

Claims 4, 5 and 26 have been rejected under 35 U.S.C. 103 over all the above discussed patents and further in view of Franz '793. At page 7 of the office action, it is argued that "all aforementioned patents teach the claimed invention as discussed above." In fact, as noted above, one of ordinary skill in the art would have to make a variety of selections from the generic disclosures of these patents in order to arrive at a composition from the scope of the present claims. The present office action fails completely to discuss why one of ordinary skill in the art would possess such motivation to make these selections. Motivation, as is well known, is required in order to support a rejection under 35 U.S.C. 103. See, for example, *In re Laskowski*, 871 F.3d 115, 10 USPQ 2nd 1397 (Fed. Cir. 1989). In the absence of an indication of why one of ordinary skill in the art would be motivated in order to select a particular layer orientation claimed herein, it is submitted that this rejection also must fail. Withdrawal thereof is therefore respectfully requested.

Claims 21, 22, 24 and 25 have also been rejected under 35 U.S.C. 103 over Schmidt or Bauer taken with Franz. This rejection is discussed above in connection with the rejection of claims 4, 5 and 26. For the same reasons, it is submitted that the rejection should be withdrawn.

Should the Examiner have any questions or comments, he or she is cordially invited to telephone the undersigned at the number below.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,



Harry B. Shubin, Reg. No. 32,004
Attorney/Agent for Applicant(s)

MILLEN, WHITE, ZELANO
& BRANIGAN, P.C.
Arlington Courthouse Plaza 1, Suite 1400
2200 Clarendon Boulevard
Arlington, Virginia 22201
Telephone: (703) 243-6333
Facsimile: (703) 243-6410

Attorney Docket No.: MERCK-2801

Date: December 14, 2005
HBS:pdr K:\Merck\2000 - 2999\2801\REPLY.doc